

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 2, 5 and 7 are amended. Claims 1-8 remain actively pending in the case. Reconsideration of the claims is respectfully requested.

In paragraph 5 on page 3 of the Final Office Action dated July 1, 2005, the Specification was objected to under 35 USC 132(a) because it introduces new matter. Applicants respectfully traverse the objection, but in the interest of furthering prosecution have amended the Specification to overcome the objection and are submitting an amended paragraph herewith. The amended paragraph clarifies the Specification and claims without adding new matter. Therefore, in view of the above remarks, Applicants respectfully request that Examiner withdraw the objection.

In paragraph 4 on page 3 of the Office Action dated December 30, 2005, claims 2, 5 and 7 were rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claims 2 and 7, MPEP §608.01(l) states:

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

However, to further prosecution, Applicants have amended claims 2 and 7. As set forth in MPEP 2173.05(h), alternative limitations using expression such as “or” are acceptable. The amendment to claims 2 and 7 have been

made merely for providing appropriate formatting in accordance with the rules. It is respectfully submitted that this change does not affect the scope of the claims. Support for claim 2 can be found on at least page 8. Support for claim 7 can be found at least in Table 1 and pages 9-10. In addition, Applicants submit that a correction to a typographical error was made to claim 2.

With respect to claim 5, Applicants have amended claim 5 to better clarify the invention and submits that the rejection is now moot. Support for the amendment can be found on at least page 8, lines 3-23 and page 10.

Therefore, in view of the above remarks, Applicants submit that the claims 2, 5 and 7 are in condition for allowance.

In paragraph 6 on page 4 of the Office Action dated December 30, 2005, claims 1-8 were rejected under 35 USC §103(a) as being unpatentable over the combination of Kaplan U.S. Patent No. 6,211,484 and further in view of Froehlich et al. "A Near-field Scanning Optical Microscope for Analysis of Magneto-Optic Media". Applicants respectfully traverse the rejection.

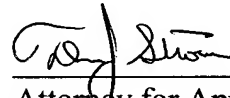
As admitted by the Office Action, Kaplan fails to teach or suggest at least reading said micro-discrete indicia using near-field optics as required in claim 1. Froehlich fails to remedy the deficiencies of Kaplan as Froehlich fails to teach or suggest at least reading said micro-discrete indicia using near-field optics. Rather, Froehlich discloses examining magnetic domain structures on magnet-optic (MO) media using a tapered fiber near-field probe, i.e., materials analysis. *See* Fig. 1 and page 84, second full paragraph. Froehlich discloses positioning the probe over the MO material wherein "[a]tomic forces between the tip and sample perturb the amplitude and phase of . . . [a] dither, which can be detected and used as a feedback signal to regulate tip position." *See* page 83, third paragraph. Then, Froehlich uses near-field scanning optical microscopy (NSOM) to study domain wall jaggedness of the MO material. *See* page 84, second full paragraph. However, Froehlich does not teach, expressly or inherently, reading micro-discrete indicia using near-field optics.

Therefore, in view of the above remarks, Applicants' claim 1 is patentable over the cited references. Because claims 2-8 depend from claim 1 and include the features recited in the independent claim, Applicants respectfully submit that claims 2-8 are also patentably distinct over the cited references.

Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.